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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,471

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Ludger Borgmann

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3686

MAIL DATE

DELIVERY MODE

06/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,471	Applicant(s) BORGMANN, LUDGER	
	Examiner Natalie A. Pass	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 18 March 2010. Claims 1-10 have been amended. Claims 11-15 have been newly added. Grounds of rejection for claims 1-15 are set forth in detail below.

Claim Objections

2. The objections to claims 6 and 8 under 37 CFR 1.75(c), as being of improper dependent form are hereby withdrawn due to the amendment filed 18 March 2010.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Newly added claims 11-15 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- “combined with data included in an associated patient data set without gaps and in a consistent manner,” as disclosed in claims 11, 12, 13, 14, 15 at lines 2-3, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 10 May 2005. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 10 May 2005.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-2, 6-7, 11-12, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 1-2, 6 recite limitations in “means plus function” language. The scope of a “means” limitation is defined as the corresponding structure or material set forth in the written description and equivalents thereof. See MPEP § 2181 through § 2186. If there is no disclosure of structure, material or acts for performing the recited function in the specification, the claim limitation lacks specificity, and fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.

Recent court cases have held that simply reciting “software” without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty v. Int'l Game Tech.*, ___ F.3d ___, 2008 U.S. App. LEXIS 6472, at *10 [86 USPQ2d 1235] (Fed. Cir. Mar. 28, 2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6.”). The Court in *Aristocrat* did not require a listing of source code or a highly detailed description of the algorithm to be used to achieve the claimed functions in order to satisfy 35 U.S.C. §112 paragraph 6. It did require, however, the disclosure of at least the

algorithm that transformed the general purpose microprocessor to a “special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming*, 184 F.3d at 1349. Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm or description of structure corresponding to the claimed function to provide the necessary structure under 35 U.S.C. §112 paragraph 6.

In the instant case, the “means plus *function*” language recited in claims 1-2, 6 lacks sufficient disclosed structure under 112, sixth paragraph, and is therefore indefinite under 112, second paragraph.

(B) Claims 11, 12, 7, 14 incorporate the features of claims 1-2, 6, through dependency, and are also rejected. See *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of

ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

8. The rejections of claims 2-5, 8-10 under 35 U.S.C. 112, second paragraph are hereby withdrawn due to the amendment filed 18 March 2010.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dewaele, U.S. Patent Number 5757021 for substantially the same reasons given in the previous Office Action (paper number 20090914). Further reasons appear hereinbelow.

(A) As per newly amended claim 8, Dewaele teaches a method for transmission of data in a diagnostic X-ray system, comprising:

producing imaging data of an X-ray exposure in response to actuation of a start switch of an X-ray apparatus (Dewaele; Abstract, column 6, lines 17-22, column 9, lines 8-12, 50-60), and

subsequent to the execution of the X-ray exposure in the X-ray apparatus, generating and transmitting a first data set for being transmitted to a further component of the diagnostic X-ray system (Dewaele; column 6, lines 32-65), the first data set (a) being assembled via a software program of an arithmetic unit started simultaneously with actuation of the start switch (Dewaele; column 7, lines 31-62, column 8, line 45 to column 9, line 12), (b) including one selected from the group consisting of (b)(i) selected parameters, (b)(ii) automatically adjusted parameters, and (b)(iii) both selected and automatically adjusted parameters of the X-ray exposure (Dewaele; column 3, lines 30-40, column 5, lines 13-16, column 6, lines 17-26, column 7, lines 9-12, column 9, lines 8-60, column 12, lines 48-60), and (c) extended with further information, wherein the further information serves to enhance protection against errors during a transmission of the first data set, the further information including (c)(i) a “system clock on the tag” (reads on “time stamp”) (Dewaele; column 3, lines 52-55, column 4, lines 36-40), (c)(ii) “a unique manufacturer’s identification number” (reads on “an unambiguous data set identification number,” (Dewaele; column 5, lines 61-63).

Dewaele fails to explicitly disclose (c)(iii) a checksum, However Dewaele teaches transmission of data over the Internet (Dewaele; column 6, lines 44-48), which includes use of a checksum, which is transmitted or stored along with the data in order to detect corruption of the data.. Examiner notes that Internet packets use a 32-bit checksum.

It is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include use of a checksum within the method disclosed by Dewaele, with the motivation of ensuring accurate transmission of the data while updating data and storing “examination specific history information along with patient identification data” (Dewaele; column 3, lines 2-6).

(B) As per newly amended claims 9-10, Dewaele teaches a method as analyzed and discussed in claim 8 above

wherein transmitting the first data set includes transmitting to a mobile patient data terminal (Dewaele; column 6, lines 32-65), the method further comprising:

forming a third data set, wherein the third data set comprises parameters of the X-ray exposure (Dewaele; column 6, lines 17-20, column 9, lines 40-51, column 10, lines 1-4, column 12, lines 48-60), preselectable patient data (Dewaele; column 3, lines 12-14, 30-34, column 5, lines 13-16), and an identification number of an image cassette on which the X-ray exposure is stored (Dewaele; column 5, lines 61-64, column 12, lines 53-60); and further comprising:

transmitting the third data set formed by the mobile patient data terminal to a data processing unit (Dewaele; column 6, lines 17-26, column 9, lines 40-51, column 10, lines 1-4, column 12, lines 48-60); and

forming a fourth data set, wherein the fourth data set comprises the parameters of the X-ray exposure (Dewaele; column 6, lines 17-26, column 9, lines 40-51, column 10, lines 1-4, column 12, lines 48-60), preselectable patient data (Dewaele; column 3, lines 12-14, 30-34, column 5, lines 13-16), and image data of the X-ray exposure (Dewaele; column 8, lines 29-35, column 9, lines 45-49, column 10, lines 1-4).

(C) As per newly added claim 15, Dewaele teaches a method as analyzed and discussed in claim 8 above, further wherein:

generating and transmitting the first data set further includes configuring the first data set for being combined with data included in an associated patient data set without gaps and in a consistent manner (Dewaele; Figure 3, column 3, lines 25-40, column 7, line 65 to column 8, line 7, column 11, lines 3-4, column 14, lines 1-7, 31-36); Examiner interprets Dewaele's teaching of encoding patient data to teach a form of "configuring the first data set for being combined with data included in an associated patient data set without gaps and in a consistent manner."

(D) Apparatus claims 1-3, 5, 11, 12, 13 repeat the subject matter of claims 8, 8, 8, 10, 15, 15, 15, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 8, 10, 15 have been shown to be obvious over the teachings of Dewaele in the above rejections of claims 8-10, it is readily apparent that the system disclosed by Dewaele includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claims 8, 10, 15, and incorporated herein.

(E) System claims 6, 7, 14 repeat the subject matter of claims 8, 9, 15, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 8, 9, 15 have been shown to be obvious over the teachings of Dewaele in the above rejection of claims 8, 9, 15, it is readily apparent that the system disclosed by Dewaele includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 8, 9, 15, and incorporated herein.

(F) As per claim 4, Dewaele teaches a mobile patient data terminal as analyzed and discussed in claim 3 above further comprising a bar code scanner for detecting an image cassette identification number, and wherein the data transmission unit is further configured (C) for forming a third data set by adding the image cassette identification number to the second data set (Dewaele; column 6, lines 32-65, column 8, lines 19-24, column 12, lines 48-60).

Response to Arguments

11. Applicant's arguments filed 18 March 2010 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 18 March 2010.

(A) At pages 9-10 of the response filed 18 March 2010, Applicant argues that the newly added features in the 18 March 2010 amendment are not taught or suggested by the

applied reference and that a *prima facie* case of anticipation has not been established. This argument is moot in view of the new ground(s) of rejection.

(B) In response to Applicant's arguments that the Dewaele reference fails to teach limitations recited in newly amended claims, all of the limitations which Applicant disputes are missing in the applied reference, including the features newly added in the 18 March 2010 amendment, have been fully addressed by the Examiner as being obvious in view of the teachings of Dewaele, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC §103 rejections given in the preceding sections of the present Office Action.

As per Applicant's arguments on page 9 of the response filed 18 March 2010 that the Dewaele reference fails to teach an x-ray apparatus that includes a "data transmission unit ... [...] ..., " as recited in claim 1, Examiner respectfully disagrees. Examiner interprets Dewaele's teachings of "the R/W device comprises means for displaying a number of destination types to which a read out image (processed or not procesed [sic]) can be transmitted ... [...] ... The given destinations are not exhaustive and comprise any device reachable and supported by current communication technology such as LAN or WAN, digital cellular wireless data transmission link, satellite link, internet link or optical link" (Dewaele; column 6, lines 32-49) to teach a form of this limitation. Moreover, the Examiner respectfully submits that limitations drawn to a "data transmission unit for generating ... [...] ..." merely constitutes the intended use of the invention. In this regard, Examiner notes that a recitation of the intended use of the claimed invention must

result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Accordingly, the issue is not whether or not Dewaele directly teaches the intended use, namely, “generating and transmitting a first data set ... [...] ...”, but rather whether the structural elements disclosed by the teachings of Dewaele are capable of “generating and transmitting a first data set ... [...] ...”. In this case, as clearly outlined by the teachings of the applied reference and the motivations and considerations of the skilled artisan, it is respectfully submitted that the teachings of Dewaele are clearly capable of performing the intended use recited by Applicant.

The remainder of Applicant’s arguments are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

13. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed,

and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any response to this final action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark "EXPEDITED PROCEDURE".

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on 9-6:30 Monday - Thursday and alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
June 16, 2010

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686